



Attorney Docket No.: 3500.244

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Junker et al.

Application No.: 09/592,032

Group Art Unit: 1653

Filed: June 12, 2000

Examiner: Liu, Samuel

Confirmation No: 5100

**RECEIVED**

DEC 13 2002

TECH CENTER 1600/2900

For: Growth Hormone Crystals

**TERMINAL DISCLAIMER UNDER 37 CFR 1.321**

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

I am an attorney of record for the instant application.

Novo Nordisk A/S is the assignee of the entire interest in the above-identified application as evidenced by the assignment from the named inventors to Novo Nordisk A/S in application 07/961,932 that was as recorded on February 4, 1993 at Reel 6423, Frame 0094.

The terminal part of the statutory term of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 5,780,599, issued July 14, 1998, is hereby disclaimed, except as provided below, and it is agreed that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 5,780,599, issued July 14, 1998, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors and assigns.

In making the above disclaimer, disclaimant does not disclaim the terminal part of any patent granted on the above-identified application that would extend beyond the expiration date of the full statutory term of U.S. Patent No. 5,780,599, issued July 14, 1998, in the event that the latter later expires for failure to

pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued in any matter or is terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

The Commissioner of Patents is hereby authorized to charge the fee required under 37 C.F.R. 1.20(d) for the filing of this Terminal Disclaimer, estimated to be \$110.00, to Deposit Account No. 14-1447. A duplicate of this sheet is enclosed.

Respectfully submitted,

Date: November 27, 2002

Richard W. Bork  
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PATENT TRADEMARK OFFICE

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 1-9-03

APPL. S.N.: 09/592,032

TO EXAMINER: S. Liu

ART UNIT: 1653

MOSE MONTGOMERY ROOM 11E18

MAILROOM DATE 12-9-02

AFTER FINAL YES NO NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

The T.D. is PROPER and has been recorded. (See 14.23).

The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

The recording fee of \$ \_\_\_\_\_ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

Application Examiner has not processed T.D. fee. (See fee authorization).

The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

The person who signed the terminal disclaimer:

has failed to state his/her capacity to sign for the business entity. (See 14.28).

is not recognized as an officer of the assignee. (See 14.29 and possibly 14.29.01).

No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

The T.D. is not signed. (See 14.26, 14.26.3) or 14.26.03 if TD is not signed by all the owners.

Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed) is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3) (For Samples 14.27.04 and 14.27.05)

Other: \_\_\_\_\_

Suggestion to request refund of \$ \_\_\_\_\_. (See 14.35, 14.36).

EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALITIES MAY BE FAXED IN TO THE GROUP

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

Sample of a TD over a pending application and assignee Certificate (See 14.37).

Sample of a TD over a prior patent and assignee Certificate (See 14.38).

Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)